DETAILED ACTION

Summary

1. Receipt of Applicant's Arguments/Remarks and amended claims filed on 03/03/08 is acknowledged.

Claims 6 and 9-10 have been cancelled. Claims 1, 2, 4, 5 and 7 have been amended. Accordingly, claims **1-5 and 7** are under prosecution.

The rejection made under 35 USC 112.2 have been withdrawn in view of applicants amendments.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 1-5 and 7 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claim 1 recites the limitation "styling polymer". The claim lacks structural limitations. In the absence of appropriate and specific

structural limitations, the phrase "styling polymer" will read on any polymer. Appropriate recitation of specific component is requested in order to deduce structural and functional relationship of the claimed composition.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

5. Claims 1-5 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cho (US patent No. 5,366,665).

Cho teaches a composition for shampoos for hair or body, conditioners and cosmetic compositions (abstract). 2-hydroxyoctanoic acid is taught in example 7 on column 27. The amount utilized in the composition is 0.12 moles. The example of polymer thickener includes vinyl polymers (see column 10, lines 19-25). The block polymers are taught in column 9, lines 58-60).

With respect to the composition being a leave on product, it is the position of the examiner that claims are given broadest reasonable interpretation during prosecution, Cho teaches shampoo which reads on leave on product specially in the absence of specific duration recited in claims with respect to leave on product. Furthermore, the limitation of the composition being a leave on product is an intended use, a recitation of

the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

Response to Arguments

6. Applicant's arguments filed 03/03/08 have been fully considered but they are not persuasive.

Applicant argues that there is nothing in Cho that discloses or suggests leave-on styling products or the use of a 2-hydroxyatkanoic acid in conjunction with a styling polymer to provide a leave-on styling product having improved high humidity hold. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (a styling polymer to provide a leave-on styling product having improved high humidity hold) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

With respect to the composition being a leave on product, it is the position of the examiner that claims are given broadest reasonable interpretation during prosecution, Cho teaches shampoo which reads on leave on product specially in the absence of specific duration recited in claims with respect to leave on product.

7. Claims 1-5 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sakuta (US Patent no. 6,984,390).

Sakuta discloses cosmetic preparations. The composition disclosed is used for shampoo, conditioner, hair coloring agents, hair tonic and cosmetic materials etc.(see paragraph [0075]. 2-hydroxyoctanoic acid is disclosed in example 21 and 22. vinyl polymers and block copolymers are disclosed in paragraph [0029] and [0062]. With respect to the composition being a leave on product, it is the position of the examiner that claims are given broadest reasonable interpretation during prosecution, Sakuta teaches shampoo which reads on leave on product specially in the absence of specific duration recited in claims with respect to leave on product. Furthermore, the limitation of the composition being a leave on product is an intended use, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

Response to Arguments

8. Applicant's arguments filed 03/03/08 have been fully considered but they are not persuasive. Applicant argues that "Sakuta discloses several other embodiments that are not disclosed in the instant claimed invention and neither of the examples in Sakuta

disclose the combination of the claimed composition nor is there any disclosure of the benefits of such combination in terms of providing a composition with improved humidity hold".

Applicants arguments are not persuasive since the open-ended "comprising language of the claims do not preclude reading any other embodiment, component or compounds in the claims. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (a styling polymer to provide a leave-on styling product having improved high humidity hold) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

With respect to the composition being a leave on product, it is the position of the examiner that claims are given broadest reasonable interpretation during prosecution, Sakuta teaches shampoo and conditioner which read on leave on product specially in the absence of specific duration recited in claims with respect to leave on product.

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within

TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Snigdha Maewall whose telephone number is (571)-272-6197. The examiner can normally be reached on Monday to Friday; 8:30 a.m. to 5:00 p.m. EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Frederick Krass can be reached on (571) 272-0580. The fax phone number for the organization where this application or proceeding is assigned is 571-273-0580. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO

Customer Service Representative or access to the automated information system, call

800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Snigdha Maewall/
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